UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2010*.

2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-20 and 22-38* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-20, 22-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 8/30/10 to the application

filed on 1/19/01 after Board decision to affirm the case on 6/29/10.

2.   Claims 2-3, and 21 are canceled previously.

3.   Claims 1, 4-20, 22-38 are pending in the case. Claims 1, 20, 34-38 are

independent claims.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.   Claim 36 is rejected under 35 U.S.C. 101 because the disclosed invention is

inoperative and therefore lacks utility.

Claim 36 is a computer readable program code for translating a source file in a source

format to a target file in a target format. The program code as claimed is merely a text

file and thus inoperative.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

7.   Claims 1, 4-20, 22-38 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention.

Regarding independent claim 1, the claim recites "a buffer to assemble the feature set"

(line 5) which is not supported in the specification. Paragraph 34 of the application

discloses that:

> "Translator 100 may assemble the description of the features read by identifier
>
> 114 as an intermediary representation, stored in any convenient manner such as
>
> in a buffer or RAM (random access memory). This intermediary representation
>
> and the storage media (e.g., buffer) in which it is stored, are interchangeably
>
> referred to herein as intermediary representation or buffer 116, 126. When the
>
> translator has read a complete description of the features of source file 110 and
>
> completely assembled the representation 116, translator 100 may use writer to
>
> write a series of commands ..."

Paragraph 43 discloses:

> "In a general implementation of translator 100, a file is created in the source
>
> format 110. Translator 100 reads the source file 110 with analyzer 114 using
>
> look-up table 120 to interpret commands associated with translatable features.
>
> When translator 100 has assembled a complete description of the features (and
>
> optionally stored the features in intermediary representation 116), writer 118
>
> looks the features up in the back-end lookup table (tag file) 122."

Clearly, the feature set is <u>not assembled by the buffer</u> but by the translator and <u>is stored</u>

<u>in the buffer</u> as an intermediary representation.   Also, it appears that the <u>assembly is</u>

<u>done by the translator at the source file</u>. Only the storing is carried out in the buffer.

Therefore, "assembling the feature set in a buffer" (claim 20), "providing a buffer to

assemble the feature set" (claim 34), "a buffer to assemble the feature set" (claim 35),

"assembling the feature set in a buffer" (claims 36 and 37), "a buffer to …and assemble

the feature set" (claim 38) are not supported in the specification.

Dependent claims 4-19, 22-33 are also rejected for fully incorporating the deficiencies of

the base claims 1 and 20.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 1, 4-19, 34-35, 38 remain rejected under 35 U.S.C. 102(e) as being

anticipated by Grobler et al. (US 2002/0052893, 5/2/02, filed 12/13/00).

Regarding independent claim 1, Grobler discloses:

-   determining a feature set of a source file at a first memory location ([0018]: the

    tags of a table in the source file where said tags, which is a set of tags, represent

    the table feature are established (or determined) in the code of the source file,

    and where the source file is in a first memory location)

-   upon the determining of the feature set, assembling the feature set in a buffer,

    the buffer at a second memory location separate from the first memory location

    ([0067]-[0069], [0071]: analyzing the tags established in the source table data

    and selecting only tags suitable for creating a target table to import to the target

    file show assembling the feature set in a buffer where data is temporarily stored

    where the buffer is separate from the source file)

-   writing the feature set into a target file in the target format (figure 7, [0068]-

    [0073], [0021]: writing the source table into the target table in the target file by

    converting the source table tags into the target table tags)

-   outputting the target file (figure 6, [0058])

Regarding claim 4, which is dependent on claim 1, Grobler discloses that features of the

feature set are selected from the group consisting of paragraph style, straddled cells in

a table, cross-referencing, pen styles in a drawing, other document formatting,

document header specification, document footer specifications, discontinuity indicator,

order indicators, location indicators, beginning indicators, ending indicators, data types,

data translation pairs, document macros, implied features, implied feature endings, and

combination thereof ([0061]: the beginning indicators and the ending indicators of the table tags are selected).

Regarding claim 5, which is dependent on claim 1, Grobler discloses mapping code fragments of the source file to a feature list ([0045], [0048]).

Regarding claim 6, which is dependent on claim 5, Grobler discloses looking up the code fragments in a front-end lookup table ([0048]-[0052]).

Regarding claim 7, which is dependent on claim 6, Grobler discloses permitting the front-end lookup table to be user modifiable ([0053], [0069]).

Regarding claim 8, which is dependent on claim 1, Grobler discloses mapping the feature set to code fragments of the target file ([0049]-[0050], [0057]-[0058]).

Regarding claim 9, which is dependent on claim 8, Grobler discloses looking up the feature set in a back-end lookup table (figures 4-5, [0050]-[0051]: making selections regarding the format of the individual columns selected for the target table implies a provided list or table for looking up the table tags before selecting).

Regarding claims 10 and 11, which are dependent on claims 5 and 1 respectively, Grobler discloses identifying a feature set of a plurality of source files having a plurality

of source formats writing the feature set into a plurality of target files having a plurality of

target formats ([0023]: the fact that the data transformation from a source file to a target

file can applied to a *plurality of documents at the same time* implies that said data can

be identified in a plurality of source files having different formats and written to a

plurality of target files having of course a plurality of target formats).

Regarding claim 12, which is dependent on claim 5, Grobler discloses identifying tokens

disposed within the source file, and associating the tokens with the feature list ([0065]:

the token "Boston" disposed in the source file is identified and associated with the tags

<TH> and </TH> among the other table tags).

Regarding claims 13-14, Grobler discloses the translator comprises a user interface

where the user interface comprises a GUI (figures 4-5, [0034]).

Regarding claim 15, which is dependent on claim 1, Grobler discloses a source format

adapter module to interface with a source file generator ([0080]).

Regarding claim 16, which is dependent on claim 15, Grobler discloses using a source

file generator to initiate translation by the translator ([0080]).

Regarding claim 17, which is dependent on claim 1, Grobler discloses using a target file

adapter module to perform secondary translation ([0080],[0085]).

Regarding claim 18, which is dependent on claim 17, Grobler discloses the target file

adapter module translates the target file into another target format ([0080]-[0086]).

Regarding claim 19, which is dependent on claim 1, Grobler discloses that the source

and the target formats are selected from the group consisting of MIF, RTF,

WordPerfect, VENTURA, Microsoft Word, Interleaf, HTML, SGML, XML, C, C++, Visual

Basic, Pascal, Java, MFC, PowerPlant, Swing, SVG, HPJ, Flash, WMF, VRML,

RenderMan, 3DMF, and combination thereof ([0080]).

Regarding independent claim 34, Grobler discloses:

- providing a feature identifier to determine a feature set of the source file ([0018]:
  the tags of a table in the source file where said tags, which is a set of tags,
  represent the table feature are established (or determined) in the code of the
  source file, and where the source file is in a first memory location)
- upon the determining of the feature set, assembling the feature set in a buffer,
  the buffer at a second memory location separate from the first memory location
  ([0067]-[0069], [0071]: analyzing the tags established in the source table data
  and selecting only tags suitable for creating a target table to import to the target
  file show assembling the feature set in a buffer where data is temporarily stored
  where the buffer is separate from the source file)

- writing the feature set into a target file in the target format (figure 7, [0068]-

[0073], [0021]: writing the source table into the target table in the target file by

converting the source table tags into the target table tags)

Independent claim 35 is a system for method claim 34, and is rejected under the same

rationale.

Regarding independent claim 38, Grobler discloses a translator comprising:

- a feature identifier having a front-end lookup table to map code fragments of the

source file to a list of features to determine a feature set of the source file at the

first memory location ([0041]: the feature set, which includes tags of the source

file, is established (or determined) in the source document table)

- a buffer to store and analyze the feature set (figures 8-9, #820-855: the fact that

the source data is temporarily stored and analyzed and a target table is created

for filling the target format implies that there is a buffer for performing storing and

creating)

- a buffer to assemble the feature set upon determining the feature set, the buffer

at a second memory location separate from the first memory location ([0067]-

[0069], [0071]: analyzing the tags in the source table data which is temporarily

stored and selecting only tags suitable for creating a target table to import to the

target file imply that there is a buffer where the source table data temporarily

stored for assembling the tags, which are the feature set, for creating the target

table, where the buffer is separate from the source file**)**

-   a feature writer having a back-end lookup table to map the feature set to HTML

    code fragments, to write the feature set into the target file in the HTML format

    (figure 7, [0068]-[0073], [0021], figures 4-5, [0050]-[0051])

Grobler does not disclose:

-   the code fragments of the source file is the MIF code

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Grobler to include MIF into Grobler since Grobler discloses

the format of the source file can be *any format* used by a database application, and the

format of the target file can be in any tag language such as HTML or XML [0080].   This

motivates to use MIF code as a format of the source file in exchanging the formats

between the source documents and the target documents.

Responses to arguments

9.   Applicant's arguments filed 8/30/10 have been fully considered.

Regarding independent claim 20 (and also claims 36 and 37), Applicants argue that

Grobler does not disclose

upon identifying the feature set, which is identified at a first memory location,

assembling the feature set in a buffer at a second memory separate from the first

memory since in Glober the source data is moved into temporary storage and then

analyzed for tags.

Regarding independent claim 20 (and also claims 36 and 37), Applicants argue that

Grobler does not disclose

upon identifying the feature set, which is identified at a first memory location,

assembling the feature set in a buffer at a second memory separate from the first

memory since in Glober the source data is moved into temporary storage and then

analyzed for tags.

Examiner agrees that the identifying of the feature set in the source file of the invention

is done prior being stored in a buffer whereas in Glober the identifying is done after

being stored in the buffer. Glober is withdrawn in the rejection of claim 20 and related

claims.

Regarding independent claims 1, 34, 35 and 38 where determining of a feature set is

claimed, it is noted that the feature set, which is the tag set of the source file is

established, which means determined in the source code of the source file at the source

file, and disclosed in Glober.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

The prior art of record is listed on PTO 892.

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cong-Lac Huynh/
Primary Examiner, Art Unit 2178
09/30/10